

### **REMARKS**

In the Office Action mailed March 25, 2005, Claims 21 and 45 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,563,221 issued to Pazos. Claims 21 and 45 are rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Published Patent Application No. 2004-0064001-A1 in the name of Ehlers. Claims 1-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,563,221 issued to Pazos in view of U.S. Pat. No. 6,077,978 issued to McDaniel et al. and further in view of U.S. Pat. No. 4,110,268 issued to Longley et al. or JP 51-101099 in the name of Nagata et al. Claim 20 is rejected under 35 U.S.C. §112, second paragraph as being indefinite. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter of Claims 26 and 27.

#### **Rejections under 35 U.S.C. §112, second paragraph**

Claim 20 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner contends that Claim 20 does not describe the role of the ion exchange resin in the refining step. Applicant has amended Claim 20 to describe the role of the ion exchange resin in the refining step.

Applicant submits that because of the above-detailed changes, the claims are in compliance with 35 U.S.C. §112, second paragraph, and respectfully request the Examiner reconsider and reverse her rejection of Claim 20 under 35 U.S.C. §112, second paragraph, as being indefinite.

#### **Rejections under 35 U.S.C. §102(b) over Pazos**

Claims 21 and 45 stand rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,563,221 issued to Pazos. Although Applicant respectfully disagrees with the Examiner's contention regarding Pazos, in the interests of expediting prosecution of the instant application, Claims 21 and 45 have been cancelled thus obviating any grounds for rejection based upon those claims.

#### Rejections under 35 U.S.C. §102(e) over Ehlers

Claims 21 and 45 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Published Patent Application No. 2004-0064001-A1 in the name of Ehlers. Although Applicant respectfully disagrees with the Examiner's contention regarding Ehlers, in the interests of expediting prosecution of the instant application Claims 21 and 45 have been cancelled thus obviating any grounds for rejection based upon those claims.

#### Rejections under 35 U.S.C. §103(a)

Claims 1-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,563,221 issued to Pazos in view of U.S. Pat. No. 6,077,978 issued to McDaniel et al. and further in view of U.S. Pat. No. 4,110,268 issued to Longley et al. or JP 51-101099 in the name of Nagata et al. Claims 21 and 45 have been cancelled, thus obviating any grounds for rejection based upon those claims. Applicant respectfully disagrees with the Examiner's contention regarding the combined teaching of the cited art.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the references in this case.

Neither Pazos nor McDaniel et al. teach or suggest a single reactor synthesis as is instantly claimed. Neither Pazos nor McDaniel et al. teach or suggest acidifying the starter such that no precipitate is formed as is instantly claimed. Neither Pazos nor McDaniel et al. teach or suggest to acidify residual basicity from a previous batch of polyol in the same reactor as is instantly claimed. Thus Pazos and McDaniel et al. fail to teach or suggest the instantly claimed invention.

Further, Longley et al. fail to add the missing teaching to Pazos and McDaniel et al. which would lead one of ordinary skill in the art to the instantly claimed invention. Longley et al. teach neutralization of alkaline or basic catalysts. Applicant is not claiming neutralization of alkaline or basic catalysts, only acidification of residual basicity in a reactor. Thus, Pazos, McDaniel et al. and Longley et al. fail to teach or suggest the instantly claimed invention.

Lastly, Nagata et al. fail to remedy the shortcomings of Pazos, McDaniel et al. and Longley et al. which would lead one of ordinary skill in the art to the instantly claimed invention. Nagata et al. teach neutralization of basic catalysts in a polyol before using the polyol to make a polyurethane.

Therefore, Applicant contends that nothing in the combined teaching of Pazos, McDaniel et al., Longley et al. or Nagata et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 1-20, 22-44 and 46 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,563,221 issued to Pazos in view of U.S. Pat. No. 6,077,978 issued to McDaniel et al. and further in view of U.S. Pat. No. 4,110,268 issued to Longley et al. or JP 51-101099 in the name of Nagata et al.

#### Objection to the specification

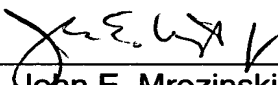
The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter of Claims 26 and 27. Applicant has amended Claims 26 and 27 to be directed to limiting the EO content of DMC-catalyzed polyols disclosed at page 10, lines 7-10 of the instant specification and respectfully request the Examiner remove her objection to the instant specification.

### Conclusion

Applicant has amended Claims 20, 26 and 27 and has cancelled Claims 21 and 45. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicant also contends that such claim amendments add no new matter and find support in the specification.

Applicant submits that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-20, 22-44 and 46. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the Applicant's attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By   
John E. Mrozinski, Jr.  
Attorney for Applicant  
Reg. No. 46,179

Bayer MaterialScience LLC  
100 Bayer Road  
Pittsburgh, Pennsylvania 15205-9741  
(412) 777-3024  
FACSIMILE PHONE NUMBER:  
(412) 777-3902  
s:\shared\kgb\jem312resp